

REMARKS

The claims of this application are being resubmitted once again in unamended form on the grounds that the Examiner has failed to establish prima facie obviousness. All of the claims of this application now stand rejected under 35 U.S.C. 103(a) over Tsumura et al. ('337) in view of Wang ('385). Based upon the Office Action, it seems that Tsumura fails to disclose as much or more than it discloses with respect to the instant claims. To fill these deficiencies, the Examiner reports the teachings of Wang on the grounds that it would have been obvious "to substitute the transmitting site 11 of Tsumura et al. with the headend 16 of Wang in order to repetitively transmit electronic program guide data over telephone exchange 20 and continuously update the program guide data at the users. By continuously caching the channel guide in advance, the set top box will have something to display immediately when viewers tune to any random channel." This observation is mere speculation on the part of the Examiner, and falls short of the standard for obviousness. In rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior-art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

In this case, there is no teaching or suggestion *whatsoever* from the prior art to combine Tsumura and Wang, let alone for the reasons set-forth by the Examiner. There is no problem or challenge stated in Tsumura which would point to a required "solution" of repetitively transmitting information regardless of whether a user's connection is in on-hook or off-hook condition. Rather, data transmission under Tsumura commences only when the receiver is in on-hook condition, and not regardless of whether it is in on-hook or off-hook condition. Although the Examiner finally concedes that Tsumura fails to disclose repetitive information transmission, the use of Wang is unjustified on the grounds that the Tsumura and Wang inventions are unrelated. Clearly, Wang has nothing to do with telephonic transmission, and therefore expressions such as "on-hook and off-hook" have no meaning. Wang is directed to an HTML program guide for an MPEG digital TV system, and not for a telephone.

If the "headend 16" of Wang were substituted for the "transmitting site 11" of Tsumura, the Tsumura system would not work, because modification would not be made at the *receiving end*, rendering the invention unfit for its intended purpose. The combination of references never produces an obvious result if intended functionality is undermined or lost.

This application was filed in the year 2000, based upon a provisional application filed in October, 1999. It is about time the Examiner simply allowed the case, since it distinguishes over all of the art thus far cited.

Respectfully submitted,

By: _____

John G. Posa

Reg. No. 37,424

Gifford, Krass, Groh, Sprinkle,

Anderson & Citkowski, PC

280 N. Old Woodward Ave., Ste 400

Birmingham, MI 48009

(734) 913-9300 FAX (734) 913-6007

Dated: May 24, 2005